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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,913	02/03/2004	Naik Praful Ramchandra	285.074	3486

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EXAMINER	
FERGUSON, LAWRENCE D	
ART UNIT	**PAPER NUMBER**
1774	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/771,913	RAMCHANDRA ET AL.	
	Examiner	Art Unit	
	Lawrence D. Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Objection

1. Applicant is advised that should claim 6 be found allowable, claims 2, 9 and 11; claims 4 and 5 and claims 8 and 10, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-11, 13-16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 5,426,141).

Akao discloses a food packaging film (column 1, lines 47-60) comprising a core layer of polyvinyl chloride, with a metallized layer and a thermoplastic layer comprising a polymer (column 10, lines 19-68) where the metallized layer is aluminum (column 12, lines 56-65). Akao further discloses the multilayer structure has LDPE and HDPE

(column 2, lines 9-15). Akao does not show that the film has a thickness or ppm as instantly claimed. However, such features are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the thickness and ppm, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness or ppm) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the flexibility and durability of the film. It would have been obvious to one of ordinary skill in the art to make the film with the limitations of the thickness or ppm since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). In claims 1-21 the term, "thermoformable" constitutes a 'capable of" limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. In claim 6, the phrase, "formed on the core layer by vacuum deposition" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Claim Rejections – 35 USC § 103(a)

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 5,492,741).

Akao discloses a packaging film (column 2, lines 3-7) comprising two polyvinyl chloride layers, a metallized layer and a silicone coating layer (column 3, lines 1-24; column 5, lines 55-67; and column 13, lines 62-65). One of the resin materials is white in color (column 14, lines 5-10) and comprises a cyclic olefin copolymer (column 10, lines 33-50). Akao further discloses the metallized layer is aluminum and the resin film comprises polyvinylidene chloride resin (column 5, lines 55-67) and the film comprises LDPE (column 3, lines 57-60). Akao does not show that the film has a thickness or ppm as instantly claimed. However, such features are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the thickness and ppm, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness or ppm) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the flexibility and durability of the film. It would have been obvious to one of ordinary skill in the art to make the film with the limitations of the thickness or ppm since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

In claims 1-21 the term, "thermoformable" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. In claim 6, the phrase, "formed on the core layer by vacuum deposition" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L. Ferguson
Patent Examiner
AU 1774

RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 4/11/06